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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/908,453	08/07/97	RUVKUN	G 08472/704002

CLARK & ELBING
176 FEDERAL STREET
BOSTON MA 02110

HM12/0719

EXAMINER

SHUKLA, R

ART UNIT	PAPER NUMBER
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1632

13

DATE MAILED:

07/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/908,453

Applicant(s)

Ruvkun et al

Examiner

Ram Shukla

Group Art Unit

1632



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-28 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

RESTRICTION/ELECTION

1. Amendment filed on 5-13-99 (Paper No. 12) is entered.
2. The restriction requirement of 4-13-99 (Paper No. 11) is withdrawn in favor of the following restriction.
3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to polypeptides, classified in class 530, subclass 350.
 - II. Claims 8-13 and 15-20, drawn to nucleic acids, classified in class 536, subclass 23.1.
 - III. Claim 14, drawn to an antibody, classified in class 530, subclass 387.1.
 - IV. Claims 21-23, drawn to gene expression modulatory compounds, classified in class 514, subclass 1.
 - V. Claims 24-28, drawn to a method of determining longevity, classified in class 435, subclass 7.1.
4. The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I, II, and III are drawn to polypeptides, nucleic acids and an antibody respectively and are patentably distinct each from the other because they are drawn to compositions of materially different characteristics. For example, the chemical structure, physical properties, and utilities of a polypeptide will be different from those of a nucleic acid or a polypeptide. Furthermore, their functions, modes of action and utilities will also be different. Therefore, analysis of the invention of the groups I, II and III will require separate searches. Additionally, there is nothing on the record to indicate that the compositions are obvious variants.

The invention of the group IV is drawn to a compound that modulates gene expression and is patentably distinct from the inventions of the groups I-III because the analysis of the invention of group IV will depend on the nature of the compound, its mechanism of affecting gene expression, for example, the step of gene expression affected, and also whether the compound inhibits gene expression or augments it.

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The invention of the group V is different from those of the inventions of the groups I-IV because it is drawn to a method and the method of group V may not use the compositions of groups I-IV or the compositions of groups I-IV can be prepared by methods other than that of the invention of group V. Additionally, the compositions of groups I-IV can be used in processes other than that of the invention of group V. Therefore, analysis of the inventions of the groups I-V will require separate and distinct searches, for example, in the non-patent literature.

5. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached on (703) 308-2801. The fax phone number for this Group is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.



BRUCE R. CAMPPELL
PRIMARY EXAMINER
GROUP 1800